

Appl. No. 10/602,441 (Docket 086/002)
Amdt. dated December 6, 2006
Reply to Office Action of June 6, 2006

Remarks/arguments:

Applicants have canceled claims 7, 8, and 13-24 without prejudice or disclaimer. Applicants reserve the right to reintroduce the subject matter of those claims at a later point in prosecution. Applicants amended claims 1-4 and 6, 9, and 10. Claims 1-6 and 9-12 are now pending in this application. Reconsideration and allowance of the application is respectfully requested.

Claim Objections

The Office objected to claims 1-24 because they had recited withdrawn subject matter. Applicants have amended the claims such that the claims are directed to the nucleic acid compositions and not protein compositions. Applicants respectfully request withdrawal of this objection.

Rejection under 35 U.S.C. §112, first paragraph (enablement)

The Office rejected claims 1-12 and 15 under 35 U.S.C. §112, first paragraph, as allegedly not being enabled by the specification. Action at page 4.

Applicants respectfully traverse the rejection. The Office stated that the specification is "enabling for a method for eliciting an immune response in a mammalian subject that is specific for its own telomerase reverse transcriptase" Action at page 4. However, the Office then argued that the specification "does not reasonably provide enablement for a method comprising immunogenic composition and GMCSF or any other pharmaceutical composition intended for the treatment of cancer." *Id.* The test for enablement is whether the disclosure enables "one skilled in the pertinent art to make and use the *claimed* invention." MPEP §2164.01 (emphasis added). Applicants note that all of the rejected claims currently pending are directed to methods for eliciting an immune response in a human that is specific for human telomerase reverse transcriptase, which are methods that the Examiner has found to be enabled. Therefore, Applicants request clarification on why the current claims are rejected as the Office seemingly has found the rejected claims to be enabled by the specification.

Applicants request reconsideration and withdrawal of the enablement rejections.

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Rejection under 35 U.S.C. §102

The Office rejected claims 13-21 and 22-24 under 35 U.S.C. §103(a) as allegedly being anticipated by Morin. Action at page 12. Applicants traverse the rejections. However, solely to facilitate prosecution and without acquiescence to the rejections, Applicants have canceled those claims. Therefore, those rejections are now moot.

Rejection under 35 U.S.C. §103(a)

The Office rejected claims 13 and 22-24 under 35 U.S.C. §103(a) as allegedly being unpatentable over Chen and Morin. Action at page 13. Applicants traverse the rejection. However, solely to facilitate prosecution and without acquiescence to the rejections, Applicants have canceled those claims. Therefore, those rejections are now moot.

The Office rejected claims 1-13 and 19 under 35 U.S.C. §103(a) as allegedly being unpatentable over Chen and Morin in view of Tian. Action at page 16.

Applicants respectfully traverse the rejection. Applicants disagree with the Office's conclusions on the motivation/suggestion and reasonable expectation of success elements. In particular, the Office points to Chen to support its contention that one skilled in the art would have had a reasonable expectation of success. The Office argues that Chen has "already shown an effective immune response by administering hTERT composition and use of other TERT with various adjuvant to generate immune response" Action at page 17. Unfortunately, the Office did not point to which of the 32 examples in Chen it was relying on to support this statement. Chen is directed to the use of human TERT as a tumor-associated antigen, and Applicants are not aware of any Example in Chen in which an immune response to human TERT is generated using non-human TERT. The current claims as amended are directed to the use of non-human mammalian TERT antigens to elicit such an immune response in a human. Therefore, Applicants contend that Chen does not support the expectation that using non-human mammalian TERT would be effective in generating an immune response to human TERT.

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Applicants request reconsideration and withdrawal of the obviousness rejections.

Fees Due

Should the Patent Office determine that a further extension of time or any other relief is required for further consideration of this application, Applicants hereby petition for such relief, and authorize the Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,

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